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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/892,043	06/26/2001	Dale F. McIntyre	83013F-P	1730

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EXAMINER

FLEURANTIN, JEAN B

ART UNIT	PAPER NUMBER
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2172

DATE MAILED: 01/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/892,043

Applicant(s)

MCINTYRE, DALE F.

Examiner

Jean B Fleurantin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Claims 1-24 remain pending for examination.

Response to Applicant' Remarks

2. Applicant's arguments, see pages 8-9, filed October 9, 2003, with respect to claims 1-24 have been fully considered but are not persuasive because of following:

A. In response to applicant's arguments on page 8, stated that "In the invention of claim 1, the service provider automatically obtains instruction stored on the user computer over the communication network and these instructions are associated with digital media stored on the user's computer. This is in contrast to the Jebens' wherein a work order prepared by the user is used to create a job order with respect to high resolution to high resolution images that are stored on the host (service provider) system." It is respectfully submitted that Jebens reference disclosed the claimed limitations as follow: a method for providing an automatic service over a communication network to a user based on stored instructions by a user on a user computer (see col. 22, lines 58-66), as claimed comprises the steps of a service provider automatically obtaining instructions stored on a user computer over said communication network (thus, when a file is detected in a destination folder, the hot folder system automatically moves the files to a processing queue and then compresses the file per predetermined compression settings, the communication portion of the local computer then establishes a connection with the host site 10, or other destination by automatically dialing or sending a network request, establishes a valid communication link, passes identification information to the destination computer and once

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communication link is established and transmits the file; cols. 18-19, lines 63-10). Further in column 23, lines 42-44, Jebens indicates the system 10 automatically connects to, and creates receiving and sending hot-folder files on the local systems of client A, User B, and Suppliers B and C. Jebens does not explicitly indicate said instructions being associated with a digital media file stored on said user computer; and implementing said instructions with respect to said associated digital image file. However, Jebens indicates upon receiving the digital image file, the hot-folding software at the host site 10 automatically decompresses the file and stores it to a receiving folder 716, the decompression and routing to the appropriate receiving folder 716 is performed pursuant to predetermined settings in the configuration database 720 at the host site 10 and the image file remains in a receiving folder 716 until the autolog server 34 is free to process the file, (see col. 19, lines 27-36); and the activity database 725 is updated by the autolog server 34 to log the arrival of the new file, a new item record is stored in the image database 727, if the new file is an image file and a thumbnail representation of the new file is stored in the image database 727 with the item record, (see col. 19, lines 37-46). It would have been obvious to one ordinary skill in the art at the time the invention was made to modify the teachings of Jebens with said instructions being associated with a digital media file stored on said user computer; and implementing said instructions with respect to said associated digital image file. Such modification would allow the teachings of Jebens to improve the accuracy and the reliability of the method and system for managing images over a communication network using user provider instructions, and to provide an intelligent order delivery system which achieves an automatic, integrated workflow for transferring digital assets between multiple users, (see col. 24, lines 2-4).

Interpretation of Claims-Broadest Reasonable Interpretation, see MPEP 2111. During patent examination, the pending claims must be 'given the broadest reasonable interpretation consistent with the specification.' Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 162 USPQ 541,550-51 (CCPA 1969).

Therefore, the rejection in last Office Action maintains.

Claim Rejections - 35 USC § 103

B. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,321,231 issued to Jebens et al. ("hereinafter Jebens").

As per claims 1, 12 and 24, Jebens teaches a method for providing an automatic service over a communication network to a user based on stored instructions by a user on a user computer (see col. 22, lines 58-66), as claimed comprises the steps of a service provider automatically obtaining instructions stored on a user computer over said communication network (thus, when a file is detected in a destination folder, the hot folder system automatically moves the files to a processing queue and then compresses the file per predetermined

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compression settings, the communication portion of the local computer then establishes a connection with the host site 10, or other destination by automatically dialing or sending a network request, establishes a valid communication link, passes identification information to the destination computer and once communication link is established and transmits the file; cols. 18-19, lines 63-10), and column 23, lines 42-44. Jebens does not explicitly indicate said instructions being associated with a digital media file stored on said user computer; and implementing said instructions with respect to said associated digital image file. However, Jebens indicates upon receiving the digital image file, the hot-folder software at the host site 10 automatically decompresses the file and stores it to a receiving folder 716, the decompression and routing to the appropriate receiving folder 716 is performed pursuant to predetermined settings in the configuration database 720 at the host site 10 and the image file remains in a receiving folder 716 until the autolog server 34 is free to process the file, (see col. 19, lines 27-36); and the activity database 725 is updated by the autolog server 34 to log the arrival of the new file, a new item record is stored in the image database 727, if the new file is an image file and a thumbnail representation of the new file is stored in the image database 727 with the item record, (see col. 19, lines 37-46). It would have been obvious to one ordinary skill in the art at the time the invention was made to modify the teachings of Jebens with said instructions being associated with a digital media file stored on said user computer; and implementing said instructions with respect to said associated digital image file. Such modification would allow the teachings of Jebens to improve the accuracy and the reliability of the method and system for managing images over a communication network using user provider instructions, and to provide an

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intelligent order delivery system which achieves an automatic, integrated workflow for transferring digital assets between multiple users, (see col. 24, lines 2-4).

As per claims 2 and 14, Jebens teaches a method according as claimed where said instruction comprises instructions relating the sale of rights to use and/or reproduce said image (see col. 9, lines 47-51).

As per claims 3 and 15, Jebens teaches a method according as claimed where said instruction comprises the purchase, use, or sale of an item displayed in said image (thus, the administrative workstation begins the housekeeping routine by generating an invoice for each of the image provider users 14, these invoices are developed by reference to the activities logged in the activity log during a pre-defined billing period, predefined ones of the events are assigned a charge by the system, all of the charges for a given image provider user 14 are preferably automatically organized and displayed in an invoice; which is readable where said instruction comprises the purchase, use, or sale of an item displayed in said image)(see col. 17, lines 43-51).

As per claims 4 and 16, Jebens teaches a method according as claimed wherein said instruction was entered on a form, (see col. , 17, lines 43-46).

As per claims 5 and 17, Jebens teaches a method according as claimed wherein said form is displayed in association with said image (thus, if the user requests thumbnails the internet server 24 will utilize the thumbnail pathnames stored in the item records identified by the search

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to locate and display thumbnail depictions of the search results on the user's display device, if the stored data files are not image files, dummy thumbnails in the form of standardized icons will preferably be displayed; see col. 12, lines 45-55).

As per claims 6 and 18, the limitations of claims 6 and 18 are rejected in the analysis of claim 1, and these claims are rejected on that basis.

As per claims 7 and 19, Jebens teaches a method according as claimed wherein the service provider recognizes that a digital image file has been identified for a service during a routine communication interval (thus, the low-resolution images downloaded to the agency preferably have a relatively low bandwidth communication requirement and can be transmitted in a relatively short amount of time; see col. 5, lines 24-35).

As per claims 8 and 20, Jebens teaches a method according as claimed wherein an electronic form is provided to the user by service provider in response to discovering of the identified digital image file (thus, the administrative workstation begins the housekeeping routine by generating an invoice for each of the image provider users 14, these invoices are developed by reference to the activities logged in the activity log during a pre-defined billing period, predefined ones of the events are assigned a charge by the system, all of the charges for a given image provider user 14 are preferably automatically organized and displayed in an invoice; see col. 17, lines 43-51).

As per claims 9 and 21, Jebens teaches a method according as claimed a metadata field of the identified digital image file is modified to reflect the data added to the electronic form (thus, the work order includes a file containing information developed by the first user outside of the system and the job order includes the file, the file may comprises a page description language file, in any of the foregoing embodiments, the work order can identify digital data contained in the subset and the job order can include the digital data identified in the work order; see col. 3, lines 59-65).

As per claims 10 and 22, Jebens teaches a method according as claimed wherein the metadata field is provided in said service provider computer, (see col. 2, lines 47-49).

As per claims 11 and 23, Jebens teaches a method according as claimed wherein the metadata field is provided in said user computer, (see col. 2, lines 47-49).

As per claim 13, in addition to the discussion in claim 1, Jebens further teaches said associated digital image file representing an image (thus, translating the digital images received by the system into a file format defined by the first asset provider user before storing the digital images in the storage device; see col. 27, lines 44-47).

Conclusion

3. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Contact Information


4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean B Fleurantin whose telephone number is 703-308-6718. The examiner can normally be reached on 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, BREENE JOHN E can be reached on 703-305-9790. The fax phone number for the organization where this application or proceeding is assigned is 703-746-7239.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.


Jean Bolte Fleurantin

2004-01-04


SHAHID ALAM
PRIMARY EXAMINER